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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,038	03/03/2004	Melissa K. Rath	ATMI-668	4823

24239 7590 08/30/2006

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EXAMINER	
LE, HOA VAN	
ART UNIT	**PAPER NUMBER**
1752	

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/792,038	RATH ET AL.	
	Examiner	Art Unit	
	Hoa V. Le	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 August 2006*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-31 and 33-59* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1,2,4-31 and 33-59* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

This is in response to 17 August 2006.

A. The record shows that:

(1) There are 52 claims as originally filed.

(2) On 27 April 2005 applicants elect invention composition of the formula G.

(3) On 28 November 2005 claims 53-59 are added in the amendment. Applicants state and urge that the method claims 58-59 are requested to be rejoined when their depended independent claim 1 composition is found to be allowed only. Therefore, no restriction is made since it has considered as non-elected invention method claims as those on the record for other method claims.

(4) On 17 August 2006 applicants state that the method claims 58-59 should be considered and examined as that of its elected independent claim 1 composition. (i) Applicants forget that they earlier state and urge that the method claims 58-59 are requested to be rejoined when their depended independent claim 1 composition is found to be allowed only on the record. (ii) Applicants do not letter recognize the method claims 58-59 has been

treated as non-elected invention method claims as those on the record. There are too many species, claims, groups of the claims and issues in each and all of them. Applicants do not remember an early issue as stated and urged on the record that has no issue earlier on the record. There are so much to be considered. Therefore, one should be carefully review each and all of them for a possible valid allowability and patent claim. Accordingly, the restriction is mainly repeated in between the invention composition claims and the invention method claims as followed:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. All claims (1-23, 53-57 and (as newly amended 59) being drawn to a (removing (stripping)) (composition (containing at least two chemical ingredients)), classified in class 430 , subclass 331.

II. All claims (24-31, 33-52 and 58) being drawn to a (removing (stripping)) method , classified in class 134, subclass 1.3.

Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a

materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a material different process such table top cleaning, machine dishwashing, drain cleaning, metal oxidizing. Applicants should show or provide a convincing evidence to the contrary. In the absence of such evidence, the restriction on the record would not be removed.

There is no evidence on the record that they are not patentably distinct. Therefore, no separate consideration or search is required. They are stood or fall together. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable

product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

(5) In the amendment filed on 18 August 2006, claim 59 has been change to a composition as that of claim 1 containing oxidant. Accordingly, the election of species between (a) an ammonium base and an alkali or alkaline earth base and (b) a strong base and an oxidants on the record is withdrawn since applicants has stated and urged on the record that an ammonium base and an alkali or alkaline earth base are strong bases together with both of them now being contain an oxidant.

(6) The election of species of formula G on the record is maintained unless applicants delete all compositions containing an ammonium base and an alkali or alkaline earth base in the next response to this Office action in order for it to be considered timely. In this case, a new election of species D^2 to R^2 will be next in line to issue. It is now clearly pointed out and set forth the record.

(7) CORRECTION: It is a typographic error. Claim ---57--- is objected to but not claim "58".

B. Other issues have not been considered until a proper and complete election as set forth in "(4)" is made and resolved.

F. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-272-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
28 August 2005

HOA VAN LE
PRIMARY EXAMINER